



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,979	10/20/2004	Hikofumi Yamamoto	F-8438	7108

28107 7590 03/17/2006
JORDAN AND HAMBURG LLP
122 EAST 42ND STREET
SUITE 4000
NEW YORK, NY 10168

EXAMINER

WILLIAMS, THOMAS J

ART UNIT	PAPER NUMBER
----------	--------------

3683

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/511,979	Applicant(s) YAMAMOTO ET AL.	
	Examiner Thomas J. Williams	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Acknowledgment is made in the receipt of the oath, the preliminary amendment, and the information disclosure statement filed October 20, 2004.

Information Disclosure Statement

2. The information disclosure statement filed October 20, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The international search authority has failed to forward the references to the Office. The examiner was able to retrieve GB 2,251,050, JP 2002-147512 and JP 2000-74115. However the remaining Japanese references are not easily obtainable, it is requested that the applicant submit their copies to the office for consideration.

Drawings

3. Figure 8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2 251 050 to Einhard et al.

Re-claim 8, Einhard et al. disclose a vibration isolation device, comprising : a first attachment member comprising a shank portion (such as elements 78/80 and 20); a second attachment member 14 has an opening; a vibration isolating base 34 is interposed between the shank portion of the first attachment portion and the opening of the second attachment portion, a cylindrical portion extends downwardly from an opening edge of the opening, a first stopper rubber 70 is formed between the cylindrical portion and the shank portion (see figure 2 and page 5 lines 24-30) for limiting a horizontal displacement; an extension portion extends from a lower end of the shank portion to face outwardly beneath the cylindrical portion and a second stopper 74 formed between the extension portion and a lower end of the cylindrical portion; the first attachment member is provided with a bracket 10 connecting the shank portion of the vibratory body side; the shank portion is constructed of a first inner cylinder 78/80 that is connected through the vibration isolating base to the second attachment member 14 and a second inner cylinder 20 that forms the first stopper part between the second inner cylinder and the cylindrical portion of the second attachment member 14 and is provided at its lower end with the extension

Art Unit: 3683

portion; the first inner cylinder is fixed, at its upper end, to the bracket, and at its lower end, to the second inner cylinder by a means of a bolt entered internally therethrough.

Re-claim 9, the first inner cylinder has a predetermined void for the bolt, the apparatus is provided with a bottom plate having a through hole for the bolt and an outwardly facing flange. The method of producing the plate is considered a product by process, wherein the process is not relevant to the apparatus claim.

6. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,242,146 to Tecco et al.

Re-claim 8, Tecco et al. disclose a vibration isolation device, comprising : a first attachment member comprising a shank portion (such as elements 122 and 140); a second attachment member 120 has an opening; a vibration isolating base 124 is interposed between the shank portion of the first attachment portion and the opening of the second attachment portion, a cylindrical portion 141 extends downwardly from an opening edge of the opening, a first stopper rubber 158 is formed between the cylindrical portion 141 and the shank portion for limiting a horizontal displacement (see column 6 lines 26-46); an extension portion 154 extends from a lower end of the shank portion to face outwardly beneath the cylindrical portion and a second stopper 156 formed between the extension portion and a lower end of the cylindrical portion; the first attachment member is provided with a bracket 118 connecting the shank portion of the vibratory body side; the shank portion is constructed of a first inner cylinder 122 that is connected through the vibration isolating base to the second attachment member 120 and a second inner cylinder 140 that forms the first stopper part between the second inner cylinder and the cylindrical portion 141 of the second attachment member 120 and is provided at its lower end

Art Unit: 3683

with the extension portion; the first inner cylinder is fixed, at its upper end, to the bracket, and at its lower end, to the second inner cylinder by a means of a bolt entered internally therethrough.

Re-claim 9, the first inner cylinder has a predetermined void for the bolt, the apparatus is provided with a bottom plate having a through hole for the bolt and an outwardly facing flange. The method of producing the plate is considered a product by process, wherein the process is not relevant to the apparatus claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Einhard et al.

Einhard et al. is silent regarding the method of producing the plate, such as by press working. The method of press working a metal element into a final form is known in the art, and

Art Unit: 3683

as such would have been obvious to one of ordinary skill in the art when having to form the plate member of Einhard et al.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tecco et al.

Tecco et al. is silent regarding the method of producing the plate, such as by press working. The method of press working a metal element into a final form is known in the art, and as such would have been obvious to one of ordinary skill in the art when having to form the plate member of Tecco et al.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Minakawa et al., Andra et al., de Fontenay, Colford and Higuchi each teach a vibration isolating device with displacement limiting means.

12. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is 571-272-7128. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan, can be reached at 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-6584.

TJW

March 14, 2006

THOMAS J. WILLIAMS
PRIMARY EXAMINER

Thomas J. Williams
AU 3683
3-14-06